

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE
THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of	Johnny Zhong et al.)	
)	
Serial No.:	10/724,426)	
)	
Filed:	November 26, 2003)	
)	
Confirmation No.	1047)	
)	Art Unit
For:	OPTICAL ADD/DROP MODULE)	2883
)	
Examiner:	Eric K. Wong)	
)	
Appeal No.:	_____)	

The Honorable Commissioner of Patents and Trademarks
Washington, D.C. 20231

REPLY BRIEF OF APPELLANT PURSUANT TO 37 CFR 41.41

This Reply Brief is responsive to the Examiner's Answer mailed February 11, 2008 (the "*Examiner's Answer*") to the Brief of Appellant filed October 16, 2007 (the "*Brief of Appellant*") and is hereby submitted to the Board of Patent Appeals and Interferences (the "Board") pursuant to the provisions of 37 CFR 41.41.

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LIST OF REFERENCES

U.S. Patent Documents

U.S. Patent No. 6,871,022 to *Xu*

U.S. Patent No. 6,278,818 to *Laming, et al.*

I. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

- Issue 1: Whether claims 6-11, 13, and 14 are unpatentable, under 35 U.S.C. §103(a), as being obvious over U.S. Patent No. 6,871,022 to Xu (“*Xu*”) in view of U.S. Patent No. 6,278,818 to Laming et al. (“*Laming*”).
- Issue 2: Whether claims 15-21, 23, and 24 are unpatentable, under 35 U.S.C. §103(a), as being obvious over *Xu* as applied to claims 6-11, 13, and 14 and further in view of what the Examiner has characterized as “applicant’s disclosure of the prior art” (see *Final Office Action* at 4).

II. REPLY TO EXAMINER ARGUMENTS

Applicant notes at the outset that the remarks, or a lack of remarks, herein are not intended to constitute, and should not be construed as, an acquiescence on the part of the Applicant: as to the purported teachings or prior art status of the cited references; as to the characterization of the cited references advanced by the Examiner; or as to any other assertions, allegations or characterizations made by the Examiner at any time in this case.

Applicant notes further that inasmuch as the *Examiner's Answer* does not advance new arguments or allegations with respect to Issue 2, that issue is not specifically addressed in this paper.

Issue 1: Whether claims 6-11, 13, and 14 are unpatentable, under 35 U.S.C. §103(a), as being obvious over Xu in view of Laming.

i. Claim 6

a. The Examiner has failed to establish that the cited references, when combined in the allegedly obvious fashion, teach or suggest all the elements of rejected claim 6

In the *Examiner's Answer*, the Examiner has made new allegations in addressing Applicant's argument that "...the Examiner has consistently failed to specifically identify the component(s) of Xu that the Examiner believes to correspond with the elements of rejected claim 6, and has instead simply relied on vague references to the art." *Brief of Appellant* at 9. In particular, the Examiner has responded to the aforementioned arguments by Applicant not with evidence and analysis, but simply by asserting:

In response to Applicant's argument that the Examiner has failed to identify which portions of the Xu reference relate to the claimed limitations, the Office submits that by citing figures (in this case Figures 6, 16A-B and 19A-B), each and every component in said figures are disclosed and identified. Applicant has selectively noted the Examiner's response to arguments from the final office action dated 12/11/06, stating Examiner has failed to specifically identify

components. The Office submits that specific parts were identified by citing the figures...

Examiner's Answer, at 5-6. The Examiner thus appears to be asserting that a vague reference to a group of five (5) figures in a reference having fifty-one (51) figures is sufficient to "...identify which portions of the ... reference relate to the claimed limitations..."

Applicant respectfully submits that such a vague reference, without more, simply does not satisfy the duties imposed on the Examiner by 37 CFR 1.104(c)(2), which provides in part that:

"In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified."

(Emphasis added). In particular, the *Xu* reference clearly "...shows or describes inventions other than that claimed by the applicant," inasmuch as *Xu* includes a total of fifty-one (51) figures. Applicant submits that this is the type of situation contemplated by the terms of 37 CFR 1.104(c)(2) that require, among other things, that the Examiner designate "the particular part relied on...as nearly as practicable."

As the rule clearly suggests then, the duty of the Examiner imposed by this rule is owed to the Applicant. Particularly, the Examiner must make clear, to the Applicant, where and how the references relied upon in the rejection purportedly disclose the claim elements – whether or not the Examiner believes that his explanation is clear is of no moment, the explanation must be clear to the Applicant. Unless and until the Examiner has made clear to the Applicant the purported correspondence between the references and the claim elements, the Examiner has failed to fully discharge the duty imposed on the Examiner by the rules. In the present case, the

fact that Applicant is unclear as to precisely what the Examiner believes to be the correlation between the references and the claim elements is *prima facie* evidence that the Examiner has not discharged the duty imposed by the rules.

As a practical matter, Applicant notes that inasmuch as *Xu* specifically labels many of the components illustrated in the figures of that reference, it would not appear to be difficult at all for the Examiner to fulfill the duties imposed by the aforementioned rule, and thereby avoid further delay in the advancement of this case, by clearly and specifically delineating, on the record, what the Examiner believes to be the precise nature of the purported correspondence between the disclosure of the references and the elements recited in the claims.

For at least the reasons set forth above, and in view of the arguments previously advanced in the *Brief of Appellant* and throughout the prosecution of this case, Applicant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness with respect to claim 6. Accordingly, the rejection of claim 6 under 35 U.S.C. § 103(a) is not well taken and should be overruled by the Board.

b. The Examiner has failed to establish that there is a reasonable expectation of success in implementing the purportedly obvious combination

The Examiner has responded to Applicant's argument that the Examiner has failed to establish that there is a reasonable expectation of success in implementing the purportedly obvious combination. In particular, the Examiner has responded to the aforementioned arguments by Applicant not with evidence and analysis, but simply by asserting that "...Since both fused fiber interleavers and the interleavers of *Xu* are both widely used in the art, there would be a reasonable expectation of success by replacing one known component with another for the purposes of reducing size." *Examiner's Answer* at 4.

Applicant notes, however, that other than this single conclusory assertion, there remains no evidence on the record to support the allegation of the Examiner that there is a reasonable expectation of success in implementing the purportedly obvious combination. In particular, the Examiner has not provided any authority for the proposition, advanced by the Examiner, that “[wide use] in the art” of two components gives rise, per se, to a reasonable expectation of success in substituting one component for the other. Nor has the Examiner provided any support for the allegation, newly advanced in the *Examiner’s Answer* (at 4), that the purportedly obvious combination would result in “reducing size,” or defined what would constitute a reduction in size. Finally, this assertion by the Examiner completely ignores the fact that, as noted in the *Brief of Appellant*, *Xu* teaches away from the purportedly obvious combination and the Examiner has failed to reconcile the claim rejections with that teaching.

For at least the reasons set forth above, and in view of the arguments previously advanced in the *Brief of Appellant* and throughout the prosecution of this case, Applicant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness with respect to claim 6. Accordingly, the rejection of claim 6 under 35 U.S.C. § 103(a) is not well taken and should be overruled by the Board.

ii. Claim 13

The Examiner has failed to establish that the cited references, when combined in the purportedly obvious fashion, teach or suggest all the elements of rejected claim 13

At the outset, Applicant notes that as discussed in the *Brief of Appellant* at VII.A.i, the Examiner has failed to establish that the references, when combined in the purportedly obvious fashion advanced by the Examiner, disclose the following elements of claim 6: an “optical add/drop module” comprising “a drop portion comprising a plurality of thin film filters, wherein

each thin film filter drops a particular channel from a WDM signal” and “an add portion that adds channels of the WDM signal dropped by the drop portion back to the WDM signal” where the add portion comprises “a first stage of interleavers, wherein each interleaver in the first stage is a fused-fiber interleaver,” “a final stage including a thin film interleaver, wherein the thin film interleaver has a flat-top frequency response,” and a “drop portion comprising a plurality of thin film filters, wherein each thin film filter drops a particular channel from a WDM signal” *and* an “add portion that adds channels of the WDM signal dropped by the drop portion back to the WDM signal.” (Emphasis added).

With respect to claim 13, the Examiner has newly asserted in the *Examiner’s Answer* that “figure 23 of the Xu reference where a description of a cascaded interleaver functions to suppress crosstalk. This suppression of crosstalk isolates channels.” *Examiner’s Answer* at 4. However, despite this new assertion, the rejection of claim 13, which depends from claim 6, is not well taken at least because of the Examiner’s failure to establish that the combination of the cited portions of *Xu* and *Laming* results in an “optical add/drop module” having each of the elements of claim 13 (by virtue of its dependency from claim 6) noted above. Moreover, the new assertion by the Examiner contains no references whatsoever to the specification.

For at least the reasons set forth above, and in view of the arguments previously advanced in the *Brief of Appellant* and throughout the prosecution of this case, Applicant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness with respect to claim 13. Accordingly, the rejection of claim 13 under 35 U.S.C. § 103(a) is not well taken and should be overruled by the Board.

CONCLUSION

Based on the foregoing, and in view of the arguments previously advanced in the *Brief of Appellant*, Appellant respectfully submits that the rejections of the claims are not well taken. Accordingly, Appellant respectfully requests that the Board reverse the Examiner's rejections of claims 6-11, 13-21, 23, and 24 pending in this application and thereby place this application in condition for immediate allowance.

This Reply Brief is

DATED this the 27th day of March, 2008.

Respectfully submitted,

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